UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,667	10/22/2001	Joshua Miles Chase	104348	5068

76863 7590 02/12/2009

KRAGULJAC & KALNAY
4700 ROCKSIDE ROAD
SUMMIT ONE, SUITE 510
INDEPENDENCE, OH 44131

EXAMINER	
CHANKONG, DOHM	
ART UNIT	**PAPER NUMBER**
2452	

MAIL DATE	DELIVERY MODE
02/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/029,667	CHASE ET AL.	
	Examiner	Art Unit	
	DOHM CHANKONG	2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 December 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *43-54* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *43-54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to Applicant's request for continued examination. Claim 50 is amended. Claims 43-54 are presented for further examination.

2. This action is a non-final rejection.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/11/2008 has been entered.

Response to Arguments

4. As to claims 43 and 54, Applicant argues that the examiner was incorrect in arguing that the secondary addresses were inherent in Schmid based on the client's requests and also maintains the argument that Schmid does not disclose maintaining access to a plurality of content addresses because the supplemental information source is local. Applicant's arguments have been carefully considered and only to the extent that the examiner's arguments improperly focused on Schmid's client, they are persuasive. However, in focusing on whether the client inherently taught transmitting a secondary content address, the examiner's reasoning was

misplaced. All that claim 43 requires is to maintain access to a plurality of content addresses but there is no language specifying what device needs to maintain access to those addresses.

Interpreting this limitation reasonably broadly, as long as Schmid teaches a web device that maintains access to secondary content over a network then Schmid inherently teaches maintaining access to the secondary content addresses as well. This inherency is based on well known knowledge in the art that content transmitted over a network will have an associated network address. Applicant argues that "there is no motivation to even add an identifier and address to the reference." However, the examiner maintains that if Schmid teaches an ad server that transmits supplemental content to a client, then the ad server must maintain the supplemental content's addresses (such as URLs) as well.

Based on this interpretation, Schmid teaches the limitation as claimed. Schmid discloses a supplemental content source that maintains access to secondary content [column 6 «lines 41-56»]. The examiner recognizes that Schmid does not expressly disclose that the supplemental content source maintains access to the secondary content addresses. However, because the content source is a network device and it returns the supplemental information to the client over a network, a network address associated with the supplemental information is inherent [column 7 «lines 3-8»: sending the supplemental information over the network to the client]. In other words, it was well known in the art at the time of Applicant's invention that because the supplemental information is stored on a network device, each of the pieces of supplemental information would have a network address (such as a URL). To further support this conclusion, the rejection relies on a new reference, Gupta, that expressly teaches transmitting supplemental

information requires a supplemental content source to maintain access to the network addresses for the supplemental information.

With respect to claim 54, while written as claiming a program product, the claim limitations are written as method steps. The claim therefore is interpreted as a method claim. Applicant is reminded that "claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed." *MPEP §2111.04*. Claim 54's preamble recites that the communications device merely be "capable of performing" the claimed steps. The phrase "capable of" renders the subsequent limitations a merely optional steps and are not required to be performed. That is, the claim only requires a device to be capable of "intercepting the initial request" but does not require the device to actually intercept the initial request. Applicant should therefore remove the phrase from the claim.

Even if the language is removed from the claim, Schmid still teaches a communication device that maintains access to a plurality of secondary content addresses. Schmid teaches a router that maintains access to the supplemental information source [Fig. 2 «items 118, 116, 130, 131»]. Since the supplemental information source maintains access to the supplemental addresses, Schmid's router "maintains" access to the supplemental addresses as required by the claim.

Finally, Applicant continues to rely on Schmid's teaching that the supplemental information source "is local" as a justification that no secondary content addresses are stored. First, Applicant's citation is incomplete – the entire sentence reads "[a]lthough the supplemental information source 16 may be local or remote *to the network server 10*, in the preferred embodiment it is local" (emphasis added) [column 6 «lines 62-64»]. Second, simply because the

information source is local to the network server does not lead to the conclusion that no secondary content addresses are stored. Content addresses are inherent in any system that teaches transmitting content over a network. If anything, the fact that the supplemental information source is local to a network server further justifies the conclusion that the information source stores (maintains access to) the network addresses for the stored supplemental information.

5. As to claim 50, Applicant argues that the advisory action impermissibly read the limitation as including a "whereby" clause and therefore the statement that "'whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited" is not applicable. This myopic argument ignores the clear language found in MPEP § 2111.04 which describes in general the non-limiting effect of "claim language that suggests or makes optional but does not require steps to be performed." Some *examples* of such claim language, *although not exhaustive*, include "whereby" clauses, "wherein" clauses, and "adapted to" clauses.

The inquiry focuses not on specific terminology but on whether the claim language *does not require steps to be performed*. One example of this inquiry may focus on whether a "whereby" clauses simply expresses the intended result of a process step. Based on the preceding language in the MPEP section, it is clear that this language from the court's opinion is not solely limited to "whereby" clauses as Applicant's argument seems to suggest. If Applicant's argument were accurate, the court's conclusion could be circumvented simply by avoiding the use of a whereby clause. Applicant's amendment remedies the deficiency found in

the prior claim language because the command now actually performs the step of controlling the requesting device.

Applicant further argues that Schmid does not disclose concurrently retrieving the initial content during the retrieval of the secondary content. Applicant argues that Schmid discloses acquiring supplemental content in distinct, serial steps. Contrary to Applicant's argument, Schmid discloses the limitation as claimed. Specifically, Schmid discloses an ad insertion machine [fig. 2 «item 126»]. If an advertisement (supplemental information) is inserted into requested content and the client receives them at the same time, then this reads on Applicant's limitation. While Schmid does not expressly disclose inserting the advertisement into the requested content prior to delivery to the client, Gupta does teach this feature. Gupta discloses inserting a local advertisement into requested content [Fig. 5 «item 506»] and delivering both the requested web page and the advertisement to the client at the same time (concurrently) [Fig. 5 «item 512»]. This combination does not result in changing Schmid's principle of operation as Applicant argues because Schmid already discloses an ad insertion machine in his system. Gupta simply discloses the functionality (inserting an ad into the requested content) that is implied by that machine.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 43, 48-50, and 52-54 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schmid et al, U.S. Patent No. 6.438.578 ["Schmid"], in view of Thompson et al, U.S. Patent Publication No. 2002|0077900, in further view of Gupta et al, U.S. Patent No. 6.487.538 ["Gupta"].

7. As to claims 43 and 54, Schmid does not disclose that the intercepting, creating, and transmitting steps occur prior to an initial request for initial content made by a requesting device arriving at an intended destination. However, performing such steps prior to delivering an initial request to an intended destination was a well known feature in the art at the time of Applicant's invention. For example, Thompson discloses such a feature in his invention directed to providing interstitial advertising. Specifically, Thompson discloses intercepting the initial request and transmitting information prior to an initial request for initial content made by a requesting device arriving at an intended destination [0034].

Thompson discloses that such a feature has the advantage of insuring that a client actually views the advertising content instead of the actual requested content [0008]. Thus, based on Thompson, one of ordinary skill in the art would have been motivated to modify Schmid's invention such that the intercepting, creating, and transmitting steps occur prior to delivering the initial request for initial content to the intended destination. Schmid's invention would be improved as secondary content would have a greater likelihood of being viewed by the client thus increasing the effectiveness of the delivery system.

8. As to claims 43 and 54, while Schmid as modified by Thompson discloses an ad server that maintains access to supplemental information, Schmid does not expressly disclose maintaining access to the network addresses for those pieces of supplemental information. However, it is inherent that the supplemental information has associated network addresses as further illustrated by Gupta. Like Schmid, Gupta is directed to a system for intercepting requests for information and retrieving supplemental content from a supplemental content source, such as an ad server [Fig. 4a | Fig. 5]. Gupta further discloses that the supplemental content source maintains access to the supplemental content and its associated supplemental content addresses [column 2 «lines 61-67» | column 3 «lines 7-10» | column 10 «lines 32-40»: "URL information specifying the advertisements for proxy 402 to fetch from the web server for the advertiser"].

Therefore, it would have been obvious to one of ordinary skill in the art that Schmid's supplemental information source maintained access to the supplemental content addresses. The combination of Schmid, Thompson, and Gupta discloses a supplemental information source that maintains access to supplemental information and its associated supplemental information addresses.

9. All citations are to Schmid unless otherwise noted.

10. As to claims 43 and 54, Schmid as modified by Thompson and Gupta discloses a method in a communications device for delivering content, the method comprising the steps of:

maintaining access to a plurality of second content addresses, each second content

address identifying secondary content located at a respective secondary content source [column 6 «lines 41-56» & *Gupta*, column 10 «lines 32-40»];

prior to an initial request for initial content made by a requesting device arriving at an intended destination [Thompson, 0034], the intended destination comprising an initial content source [Figure 1 «items 14, 24, 12» | column 10 «lines 17-21»]:

intercepting the initial request [Figure 1 «item 24» | column 9 «lines 65-67» where : interception means intercepts a packet intended for the requested information source | column 10 «lines 17-21»] ;

creating redirection information by processing at least one request criteria extracted from the intercepted initial request to determine an identity of secondary content to be retrieved by the requesting device [column 6 «lines 48-50» where : Schmid does not expressly disclose extracting request criteria. However, Schmid discloses that the advertisements are "related in some way to the requested information." This teaching implies extracting from the requested information some criteria in order to retrieve the related advertisements]; and

transmitting the redirection information to the requesting device [column 6 «lines 41-44» : instructions cause the client to request the supplemental information & *Thompson*, 0035, providing a web page with links that redirect the client to the additional advertisements].

11. As to claim 48, Schmid as modified by Thompson and Gupta discloses creating redirection information includes:

concatenating a first redirection code and at least one second redirection code; the first redirection code operable to instruct the requesting device to reinitiate retrieval of the initial content; the at least second redirection code operable to instruct the requesting device to initiate retrieval of the second content [column 6 «lines 8-28 and 41-44» where : Schmid's request instructions for the requested information and the supplemental information read on Applicant's redirection code];

including a delimiter separating the first redirection code and the redirection code [column 6 «lines 8-28 and 41-44» where : Schmid does not expressly disclose a delimiter. However, a delimiter is merely a character or series of characters to mark a boundary between regions in a data stream such as a within a packet. Delimiters are well known in the art and are necessary to enable a requesting device to differentiate between the request instructions for the requested information and the supplemental information. Therefore, a delimiter separating the codes is implied].

12. As to claim 49, Schmid as modified by Thompson and Gupta discloses:

including an address of the initial content source in the first redirection code [column 5 «lines 28-35»; and

including an address of the at least one secondary content source in the second redirection code [column 6 «lines 41-47»].

13. As to claim 50, Schmid as modified by Thompson and Gupta discloses:

providing a command to the requesting device via the redirection information, where the command controls the requesting device to concurrently retrieve the initial content during retrieval of the secondary content [column 6 «lines 8-28 and 41-44» : the format and request instructions cause the requesting device to request both the requested and supplemental information | Fig. 2 «item 126»: ad insertion machine & *Gupta*, column 13 «lines 60-63»: inserting ads into requested web content | column 14 «lines 4-6»: delivering the requested web content and supplement content concurrently to the client].

14. As to claim 52, Schmid as modified by Thompson and Gupta discloses:

determining the identity of the secondary content relative to at least one of a geographic indication, a source indication, and a content indication in the at least one request criteria extracted from the intercepted initial request [column 6 «lines 48-50»].

15. As to claim 53, Schmid as modified by Thompson and Gupta discloses intercepting the initial request at an entry point to the Internet [Figure 1 «item 10»].

16. Claims 44-47 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schmid, Thompson, and Gupta, in view of Bandera et al, U.S. Patent No. 6.332.127 ["Bandera"].

17. As to claim 44, Schmid as modified by Thompson and Gupta does not expressly disclose extracting the at least one request criteria from at least one protocol header and matching the extracted request criteria to at least one of the plurality of secondary content addresses. However,

such a feature was well known in the art at the time of Applicant's invention. For example, Bandera the claimed features. Specifically, Bandera discloses extracting a request criteria from the least one protocol header on the intercepted initial request [column 6 «lines 57-60» | column 7 «lines 9-17» : location information is conveyed within the HTTP header]. Bandera also discloses matching the at least one extracted requested criteria to at least one of the plurality of secondary content addresses [column 7 «lines 20-27» : plurality of advertising objects that are mapped to location information].

It would have been obvious to one of ordinary skill in the art to have modified Schmid to include the extraction and matching functionality as taught in Bandera. One would have been motivated to adapt Schmid as Bandera teaches that such functionality provides the ability to provide relevant advertisements to a user based on the extracted criteria (location).

18. As to claim 45, Schmid as modified by Thompson and Gupta does not expressly disclose the matching feature in claim 44 further includes determining desirable secondary content by identifying at least one of the plurality of secondary content addresses that maps to content related to the at least one extracted request criteria or capturing an address from the at least one of the plurality of secondary content addresses. However, these features were well known in the art at the time of Applicant's invention.

Bandera discloses both:

determining desirable secondary content by identifying at least one of the plurality of secondary content addresses that maps to content related to the at least one extracted request

criteria [column 7 «lines 24-27» : lookup table with associations between advertising objects and location information]; and

capturing an address from the at least one of the plurality of secondary content addresses that maps to content related to the at least one extracted request criteria [column 7 «lines 28-40»].

It would have been obvious to one of ordinary skill in the art to have modified Schmid with Bandera's teachings of identifying secondary content addresses that are mapped to the requests in order to tailor the secondary content to user interests. One would have been motivated to adapt Schmid as Bandera teaches that such functionality provides the ability to provide relevant advertisements to a user based on the extracted criteria (location).

19. As to claim 46, Schmid as modified by Thompson and Gupta does not expressly disclose identifying at least one of the plurality of secondary content addresses including at least one of identifying content based on a source, geographic, or content indication related to the at least one extracted request criteria.

Bandera discloses identifying content that has at least one geographic indication related to at least one geographic location of the communications device or from the at least one extracted request criteria [column 7 «lines 32-40»]. It would have been obvious to one of ordinary skill in the art to have modified Schmid with Bandera's teachings of identifying secondary content addresses related to the geographic location of the communications device. One would have been motivated to adapt Schmid as Bandera teaches that such functionality

provides the ability to provide relevant advertisements to a user based on the extracted criteria (location).

20. As to claim 47, Schmid as modified by Thompson and Gupta discloses capturing at least one Internet address for at least one advertisement that is related to the at least one extracted request criteria, the at least one advertisement programmed to be displayed with respect to a display of the initial content [column 6 «lines 48-50» where : Schmid does not expressly disclose extracting request criteria. However, Schmid discloses that the advertisements are "related in some way to the requested information." This teaching implies extracting from the requested information some criteria in order to retrieve the related advertisements]. Also, see Bandera [column 7 «lines 15-27»].

21. Claim 51 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schmid, Thompson, and Gupta, in view of Subramaniam.

22. Schmid as modified by Thompson and Gupta does not expressly disclose providing to a delimiter to be detected by the requesting device, such detection indicating to the requesting device an existence of a secondary content condition. However, such a feature was well known in the art at the time of Applicant's invention. For example, Subramaniam discloses providing a delimiter to be detected by the requesting device, such detection indicating to the requesting device an existence of a secondary content condition [column 7 «lines 12-20 and 47-58»]. It would have been obvious to one of ordinary skill in the art to have modified Schmid's system to

include the delimiter feature as taught in Subramaniam. Subramaniam discloses that the delimiter enables two different URLs to be sent as a single URL.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571.272.3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Examiner, Art Unit 2452